

**REMARKS**

Claims 1 through 19 are currently pending in the application.

Claims 1 through 19 stand rejected.

Applicants propose to amend claims 1 and 13, and respectfully request reconsideration of the application as proposed to be amended herein.

**35 U.S.C. § 102 Anticipation Rejections**

Anticipation Rejection Based on U.S. Patent 5,922,620 to Shimomura et al.

Claims 1 through 7 and 10 through 12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Shimomura et al. (U.S. Patent 5,922,620). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants assert that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

*Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Applicants assert that the Shimomura et al. reference does not and cannot anticipate the claimed invention of presently amended independent claim 1 under 35 U.S.C. § 102 because the Shimomura et al. reference does not identically describe, either expressly or inherently, each and every element of the claimed invention or presently amended independent claim 1 is as complete detail as contained in the claim. Applicants assert that the Shimomura et al. reference does not identically describe the element of the claimed invention of presently amended independent claim 1 calling for "dispensing an etchant through another tubular member having a portion thereof surrounded by the tubular member having at least one thin annular edge thereon onto the area of the wafer using the etchant-dispensing apparatus to clean material from the wafer". In contrast to the elements of the claimed inventions of presently amended independent claim 1, the

Shimomura et al. reference merely describes the dispensing of a polishing slurry for a chemical mechanical planarization process. Such is not the claimed invention of presently amended independent claim 1. Therefore, presently amended independent claim 1 is allowable as well as dependent claims 2 through 7 and 10 through 12.

Anticipation Rejection Based on U.S. Patent No. 5,922,620 to Shimomura et al.

Claims 13 through 15, 18 and 19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Shimomura et al. (U.S. Patent 5,922,620). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants again assert that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Applicants assert that the Shimomura et al. reference does not and cannot anticipate the claimed invention of presently amended independent claim 13 under 35 U.S.C. § 102 because the Shimomura et al. reference does not identically describe, either expressly or inherently, each and every element of the claimed invention or presently amended independent claim 13 is as complete detail as contained in the claim. Applicants assert that the Shimomura et al. reference does not identically describe the element of the claimed invention of presently amended independent claim 13 calling for "dispensing an etchant through another tubular member having a portion thereof surrounded by the tubular member having at least one thin annular edge thereon onto the at least one area of the wafer for selectively removing a material from a wafer". In contrast to the elements of the claimed inventions of presently amended independent claim 13, the Shimomura et al. reference merely describes the dispensing of a polishing slurry for a chemical mechanical planarization process. Such is not the claimed invention of presently

amended independent claim 13. Therefore, presently amended independent claim 13 is allowable as well as dependent claims 14, 15, 18, and 19.

### 35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,922,620 to Shimomura et al. in view of U.S. Patent No. 5,722,875 to Iwashita et al.

Claims 8 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura et al. (U.S. Patent 5,922,620) in view of Iwashita et al. (U.S. Patent 5,722,875). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Applicants assert that any combination of the Shimomura et al. reference and the Iwashita et al. reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed invention of presently amended independent claims 1 and 13 from which dependent claims 8 and 16 depend respectively because any combination of the cited prior art, at the least, does not teach or suggest all the claim limitations of presently amended independent claims 1 and 13. Applicants assert that any combination of the Shimomura et al. reference and the Iwashita et al. reference does not teach or suggest the claim limitations of presently amended independent claims 1 and 13 calling for "dispensing an etchant through another tubular member having a portion thereof surrounded by the tubular member having at

least one thin annular edge thereon onto the area of the wafer using the etchant-dispensing apparatus to clean material from the wafer” and for “dispensing an etchant through another tubular member having a portion thereof surrounded by the tubular member having at least one thin annular edge thereon onto the at least one area of the wafer for selectively removing a material from a wafer”. In contrast to the claimed inventions of presently amended independent claims 1 and 13, both the Shimomura et al. reference and the Iwashita et al. references, either individually or in any combination thereof, merely teach or suggest the dispensing of a polishing slurry for a chemical mechanical planarization process. Such is not the claimed inventions of presently amended independent claims 1 and 13. Accordingly, presently amended independent claims 1 and 13 are allowable as well as dependent claims 8 and 16 therefrom respectively.

Obviousness Rejection Based on U.S. Patent 5,922,620 to Shimomura et al. in view of U.S. Patent 6,190,236 B1 to Drill

Claims 9 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimomura et al. (U.S. Patent 5,922,620) in view of Drill (U.S. Patent 6,190,236 B1).

Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

After carefully considering the cited prior art, the rejections, and the Examiner’s comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Applicants assert that any combination of the Shimomura et al. reference and the Drill reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103

regarding the claimed invention of presently amended independent claims 1 and 13 from which dependent claims 9 and 17 depend respectively because any combination of the cited prior art, at the least, does not teach or suggest all the claim limitations of presently amended independent claims 1 and 13. Applicants assert that any combination of the Shimomura et al. reference and the Iwashita et al. reference does not teach or suggest the claim limitations of presently amended independent claims 1 and 13 calling for “dispensing an etchant through another tubular member having a portion thereof surrounded by the tubular member having at least one thin annular edge thereon onto the area of the wafer using the etchant-dispensing apparatus to clean material from the wafer” and for “dispensing an etchant through another tubular member having a portion thereof surrounded by the tubular member having at least one thin annular edge thereon onto the at least one area of the wafer for selectively removing a material from a wafer”. In contrast to the claimed inventions of presently amended independent claims 1 and 13, both the Shimomura et al. reference and the Drill references, either individually or in any combination thereof, merely teach or suggest the dispensing of a polishing slurry for a chemical mechanical planarization process and using a vacuum to remove the polishing slurry. Such is not the claimed inventions of presently amended independent claims 1 and 13. Accordingly, presently amended independent claims 1 and 13 are allowable as well as dependent claims 9 and 17 therefrom respectively.

#### ENTRY OF AMENDMENTS

The proposed amendments to claims 1 and 13 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application to clearly comply with the provisions of 35 U.S.C. § 132. Further, the amendments are timely filed, do not raise new issues place the application in condition for allowance, and does not require a further search or consideration. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

**CONCLUSION**

Claims 1 through 19 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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